

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the comments which follow.

Claims 1-27 were pending in this application. In this response, claims 1-5, 7 and 11-12 have been amended and claim 8 canceled. Thus, claims 1-7 and 9-27 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, page 3, lines 17 *et seq.* and page 4, lines 28-29.

REJECTIONS UNDER 35 U.S.C. § 112

Claims 5, 7 and 11-12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons presented on page 2 of the Official Action. In this response, claims 5, 7 and 11-12 have been amended to address this noted language. Reconsideration and withdrawal of the rejections is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-2, 4-12, 14, 20 and 24-27 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0060967 to Yang et al. (hereafter “Yang”) on the grounds set forth at page 3 of the Official Action. This rejection is respectfully traversed in view of the amendment to claim 1.

Claim 1 has been amended to recite the feature of the strip material having a surface roughness of $R_a < 0.2 \mu\text{m}$. This feature previously appeared in claim 3, a claim not subject to rejection based on *Yang*. As such, independent claim 1 and all of its dependent claims now distinguish over the disclosure in *Yang* for at least the same reasons as prior claim 3.

Not only does *Yang* not disclose the claimed surface roughness, but *Yang* teaches away from such a smooth roughness as claimed. Namely, for at least the use of alumina forming alloys, the surface is actually roughened by the formation of “cauliflower-like growths” or “cauliflower-like nodules” (see, e.g., paras., [0017] and [0054]).

Accordingly, reconsideration and withdrawal of the rejections based on *Yang* are respectfully requested.

Claims 1-3, 7, 9, 14, 20-23 and 25-27 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0229031 to Gell et al. (hereafter “*Gell*”) on the grounds set forth at page 5 of the Official Action. This rejection is respectfully traversed in view of the amendment to claim 1.

Claim 1 has been amended to recite the feature of at least one additional layer of zirconia deposited on top of the at least one layer of zirconia which is in direct contact with the steel strip material or in direct contact with a metallic bond-coat which in turn is in direct contact with the steel strip material. This feature previously appeared in claim 8, a claim not subject to rejection based on *Gell*. As such, independent claim 1 and all of its dependent claims now distinguish over the disclosure in *Gell* for at least the same reasons as prior claim 8.

Moreover and in regard to amended claim 3, Applicant notes that the claimed surface roughness is Ra less than 0.1 μm . In contrast, *Gell* recites that the substrate has a average roughness (Ra) greater than or equal to about 0.1 micrometers, preferably greater than or equal to about 5.0 micrometers (see, para. [0041]). Thus, *Gell* cannot anticipate at least this further claim.

Accordingly, reconsideration and withdrawal of the rejections based on *Gell* are respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Yang* as applied to claims 1 and 12 above on the grounds set forth at page 7 of the Official Action. This rejection is respectfully traversed in view of the amendment to claim 1.

Claim 1 has been amended to recite the feature of the strip material having a surface roughness of Ra < 0.2 μm . This feature previously appeared in claim 3, a claim not subject to rejection based on *Yang*. As such, independent claim 1 and all of its dependent claims now distinguish over the disclosure in *Yang* for at least the same reasons as prior claim 3. Accordingly, reconsideration and withdrawal of the rejections based on *Yang* are respectfully requested.

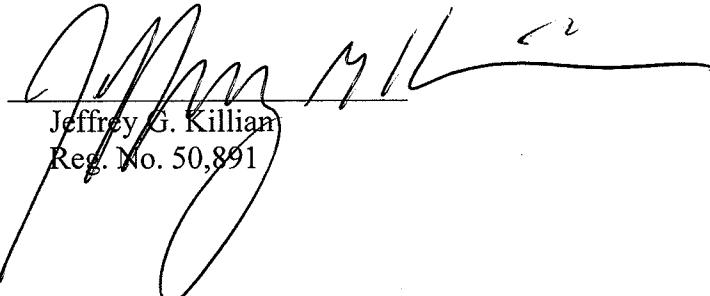
CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

By:


Jeffrey G. Killian
Reg. No. 50,891

Date: January 5, 2010

CUSTOMER NO. 055694
DRINKER, BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209
Tel: (202) 842-8800
F: (202) 842-8465